

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS SHENG

Appeal No. 2000-0412
Application No. 09/046,200

ON BRIEF

Before HAIRSTON, RUGGIERO, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-5,
which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

The appellant's invention relates to a flat bed image scanner. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A flat bed image scanner for scanning a document to obtain data for digital processing, comprising:

a glass window for placing said document;

a contact image sensor for scanning said document;

at least two lubricating guide rails placed between said contact image sensor and said glass window to reduce friction and to reduce fluctuation in mechanical dimension between said contact image sensor and said glass window when said contact image sensor slides along said glass window;

a nest for recessing said contact image sensor;

an elastic element placed in said nest for pushing said contact image sensor against said window; and

a sliding mechanism for sliding said nest so that contact image sensor can scan said document.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Itoh

5,734,483

Mar. 31, 1998
(Filed Sep. 17, 1996)

Claims 1-5 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No.

5,801,851.¹ Claims 1-5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Itoh in view of well-known prior art (for example, Tsuchiya, Patent No. 5,012,354).²

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 11, mailed Jun. 16, 1999), the response to appellant's appeal brief filed Feb. 25, 2003 and the Board Remand (Paper No. 14, mailed Aug. 29, 2002) (herein referred to as "examiner's response") and the supplemental examiner's answer (Paper No. 17, mailed May 13, 2003) for the examiner's reasoning in support of the rejections, and to the appellant's (marked up version) of the brief (Paper No 16, filed Feb. 25, 2003) (herein referred to as "supplemental brief"),

¹The examiner only lists claims 1, 2, 4 and 5 in the summary paragraph, but addresses all five claims in the text of the rejection/correlation to the claims of U.S. Patent 5,801,851.

² The examiner still has not presented a clear statement of the rejection as to the references relied upon to reject the claims. In the response to appellant's response to our remand, the examiner indicated in paper number 17, mailed May 13, 2003 that the Tsuchiya reference is relied upon by the examiner as "evidential support" as to what is common knowledge with respect to a plural guide rail system as shown in Figure 3(a). But, in the supplemental answer, the examiner stated that claims 1-5 are rejected as "unpatentable over Itoh in view of (*Tsuchiya 5,012,354, found in response to appellant's April 15, 1999 amendment*)."

(See supplemental answer at page 10.) Since it is still unclear to us and the examiner would be required to reopen prosecution to institute a new ground of rejection in the answer, we will treat the claims as rejected over Itoh in view of common knowledge.

appellant's brief (Paper No. 9, filed May 28, 1999) and reply brief (Paper No. 12, filed Aug. 6, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Initially, we remanded this application to the examiner and appellant to clarify the status of the rejections and responses. Rather than remand this application again for additional clarification, we will decide the appeal based upon the rejections and responses as presented by the examiner and appellant.

OBVIOUSNESS-TYPE DOUBLE PATENTING

From our review of the brief, we note that appellant has indicated that the double patenting rejection remains an issue at page 1 of the brief and provides no specific argument in response thereto in the originally filed brief. Nor do we find a specific argument in the reply or the supplemental brief beyond some analogy to a circus juggler that may or may not be directed to the disclaimer of subject matter. We do not understand this analogy by appellant, and do not find it persuasive to the specific

rejection and correlation by the examiner at pages 7-9 of the answer. While appellant has filed a paper identified as a terminal disclaimer on Nov. 12, 1998 (Paper No. 4), appellant has not paid the requisite fee prior to our review of this administrative record. The examiner repeated the double patenting rejection in the answer and appellant indicated in the reply that the terminal disclaimer and the fee will be submitted in due time if the Appeal is granted. Therefore, appellant has not overcome the double patenting rejection by presenting persuasive argument or obviating the rejection by filing a terminal disclaimer and required fee. Since the examiner has presented a ***prima facie*** case of obviousness-type double patenting which has not been obviated or rebutted by appellant, we must sustain the examiner's rejection of claims 1-5.

35 U.S.C. § 103

Since the examiner has indicated that Tsuchiya is merely evidence of the use of two guide rails and the examiner lists Tsuchiya parenthetically in the statement of the rejection in the answer and the supplemental answer, but does not mention this reference in the text of the rejection in the originally mailed rejection, we will treat the rejection as based on Itoh alone. In the supplemental answer, the examiner discusses Tsuchiya with respect to securing and strengthening the support of the image sensing means as it travels. (See supplemental answer at pages 11 and 12.) Yet at page 11 of the supplemental answer the examiner maintains that:

[T]he use of two guide rails is superfluous since Itoh provides a teaching of a successful flat bed scanner having a contact type image [sensor] recessed in a nest 14 which **has a single guide rail**. The use of plural guide rails provides no patentable advantage. Rather it is a design choice to [have] more than one guide rail when the prior art shows utility with only one guide rails [sic, rail]. The use of plural guide rails provides no patentable feature.

Therefore, the examiner concludes that it would have been obvious in view of Itoh to use a plurality of guide rails for design or aesthetic purposes when the use of one performs the same function as a plurality of guide rails.

Here, we find no support in the teachings of Itoh to support the examiner's finding of design or aesthetic purposes in the use of two guide rails as stated in the supplemental examiner's answer. The mere fact that the examiner has cited the teachings of Tsuchiya without specifically including Tsuchiya in the rejection and providing a line of reasoning does not mean that the teachings of Tsuchiya are conclusive evidence that plural guide rails were common knowledge and that they were desirable over a single guide rail system as taught by Itoh. The examiner has cited to no portion of Tsuchiya other than Figure 3A generally.

Appellant merely maintains that the guide rails and the lubricating pads serve different functions at page 2 of the brief and that three supporting points can be held more accurately and more closely with respect to the window. We find no specific argument with respect to the prior art to Itoh in appellant's brief. Appellant argues that the guide in Itoh is different from the lubricating guides in the present invention and that the lubricating guides of 52 (a) and 52(b) of the present invention rest on the scan

window and keep a constant distance between the image sensor and the glass window (for unevenness) as recited in the language of independent claim 1. (See reply brief at page 1.) Independent claim 1 recites “at least two lubricating guide rails placed between said contact image sensor and said glass window to reduce friction and to reduce fluctuation in mechanical dimension between said contact image sensor and said glass window when said contact image sensor slides along said glass window.” We find that the examiner is viewing the single support rail of Itoh and the two support rails of Tsuchiya as teaching this element of the claim. We disagree with the examiner since the guide rails of Itoh and Tsuchiya are not between the sensor and the glass. From the sweeping nature of the examiner’s rejection and the lack of any specific teaching in the prior art to Itoh of the use or desirability of the use of plural guide rails between the sensor and the glass, we find that the examiner has not set forth a ***prima facie*** case of obviousness of the invention as recited in independent claim 1, and we will not sustain the rejection of independent claim 1 and its dependent claims.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-5 under 35 U.S.C. § 103 is reversed, and the decision of the examiner to reject claims 1-5 under obviousness-type double patenting is affirmed.

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No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED

KENNETH W. HAIRSTON
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

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